REMARKS

After entry of the foregoing amendments, claims 34-39, 41, 43-51, 53, and 58-70 are now pending in this application. Claims 34-36, 39, 41, 43-46, 49, and 53 are presently amended and claims 58-70 have been added. Claims 40, 42, 52, and 54-57 have been cancelled without prejudice or disclaimer, reserving the right to reinstate the claims. No new subject matter has been added by these amendments.

Rejections under 35 U.S.C. § 101

In the Office Action, the invention was rejected as being directed to non-statutory subject matter. Additionally, the Examiner states that the claimed subject matter is subject to a non-statutory double patenting rejection. Further, claims 54-57 were rejected on the grounds that a database is not tangible.

First, the Applicants respectfully assert that the invention is directed to statutory subject matter. 35 U.S.C. § 101 sets forth as categories of statutory subject matter a process, machine, manufacture, or composition of matter. The Applicants' invention clearly falls within at least one of these categories, being directed to at least a process and machine. More specifically, independent claim 34 recites "[a] method for processing and storing electronic billing information," falling within the statutorily prescribed category of a process. Furthermore, the Applicants have amended claim 34 to further include "transmitting the generated bill summary information to the customer for display to the customer," producing a useful, concrete, and tangible result and thus within the realm of statutory subject matter per 35 U.S.C. § 101. *See* AT&T Corp. v. Excel Communications, Inc., 172 F.3d 1352, 1358, 50 USPQ2d 1447, 1452 (Fed. Cir. 1999) ("Because the claimed process ... produce[s] a useful, concrete, tangible result without pre-empting other uses of the mathematical principle, on its face the claimed process comfortably falls within the scope of § 101"); State Street Bank & Trust Co. v. Signature Fin. Group, Inc., 149 F.3d 1368, 1373, 47 U.S.P.Q.2D (BNA) 1596, 1601 (Fed. Cir. 1998). Additionally, independent claim 44 is directed to a computer-implemented system for processing and storing electronic billing information, which clearly falls within a statutory subject matter category of a machine. *See* MPEP § 2106.01 (stating that if a computer program is being claimed as part of an otherwise statutory manufacture or machine, "the claim remains statutory irrespective of the fact that a computer program is included in the claim"). Finally, the

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Applicants' invention does not fall within any of the judicially created exceptions to statutory subject matter - abstract ideas, natural phenomena, and laws of nature. *See* Diamond v. Diehr, 450 U.S. 175, 185, 209 USPQ 1, 7 (1981) (recognizing the limits to patentable subject matter as abstract ideas, natural phenomena, and laws of nature); Pioneer Hi-Bred Int'l, Inc. v. J.E.M. Agric. Supply, Inc., 200 F.3d 1374, 1376, 35 USPQ2d 1440 (Fed. Cir. 2000) (classifying abstract ideas, natural phenomena, and laws of nature as the three categories that are not patentable, while at the same time acknowledging that the patent system has applications in all areas of technology-based commerce) ; *see also* MPEP § 2106 pt. IV. Accordingly, because the Applicants' claims clearly fall within at least one of the four statutory categories under § 101, and because the claims are not directed towards the judicially excepted areas, the Applicants respectfully assert that their invention is directed toward statutory subject matter under § 101.

Second, with respect to the Examiner's rejection of claims 34-57 on the ground of nonstatutory obviousness-type double patenting, the Applicants, to further expedite examination, have submitted herewith a terminal disclaimer disclaiming the terminal part of the statutory term of the present application that would extend beyond the term of U.S. Patent No. 6,289,322. Therefore, the Examiner's rejection of claims 34-57 on the ground of nonstatutory obviousness-type double patenting is rendered moot.

Third, with respect to the Examiner's rejection of claims 54-57 on the grounds that a database is not tangible, the Applicants have cancelled claims 54-57, without prejudice or disclaimer, in an effort to reduce the number of issues under examination and further expedite examination. Therefore, the Examiner's rejection of claims 54-57, on the grounds that a database is not tangible, is rendered moot.

Accordingly, the Applicants respectfully assert that amended independent claims 34 and 44 fully comply with the subject matter requirements of 35 U.S.C. § 101 and are in condition for allowance. Likewise, dependent claims 35-43 and 45-53 are allowable as a matter of law, depending from an allowable claim, notwithstanding their independent recitation of patentable features.

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Rejections under 35 U.S.C. § 102(a)

In the Office Action, the Examiner rejected claims 34-57 under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent No. 5,699,528 to Hogan ("Hogan"). The Examiner states that Hogan discloses a method and corresponding system and database for bill delivery and payment substantially as claimed in the present application.

Hogan generally discloses communicating "bill images" electronically to payors (also referred to herein as customers), wherein these "bill images" replicate the form and content of the paper bills that would be sent by a biller. More specifically, Hogan is directed towards two general embodiments – the first, in which the bill images are generated at and transmitted by a computer server to a remote payor; and the second, in which bill information is communicated via email protocol and electronic bills are compiled on the payor's system.

In the first embodiment of Hogan, the server computer stores "billing data ... in such a form that the subscribers are allowed to view full graphics of their bills." (*See* col. 5, lines 6-8.) The payors are required to manually step through the detailed bill images one at a time, without being able to view summary bill information. (*See* col. 6, lines 20-30.) The first embodiment of Hogan does not teach generating, storing, or transmitting summary bill information at a central location.

In the second embodiment of Hogan, bill information is communicated to the payors as "electronic bills" via email communications in coordination with an electronic bill payment software application running on the payors' personal computers that analyzes header information and parses email subject fields. Although Hogan, in this embodiment, teaches compiling and displaying a list of unopened bills together with unpaid bills, Hogan's teaching is limited to the use of an electronic bill payment software application running locally on the payors' personal computers. Specifically in this embodiment, Hogan requires: (1) formatting bill data as "electronic bills" in the form of email messages, (*see* col. 9, lines 7-12); (2) transmitting these email messages to payors via email protocol, (*see* col. 9, lines 12-14); and (3) software running locally on the payors' computers that processes the email messages, (*see* col. 9, lines 26-31, and col. 9, line 61 to col. 10, line 63).

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The present invention is generally directed towards a method and computer-implemented system for processing, storing, and transmitting bill electronic bill information that includes generating, storing, and transmitting summary bill information to a payor/customer. More specifically, independent claim 34, and similarly independent claim 44, have been amended to recite "processing bill data to generate bill summary information, *wherein the processing occurs at a location remote from a customer associated with the bill data and a location remote from a biller associated with the bill data.*" Thus, the present invention, after receiving bill information from a biller, processes the bill information to generate bill data, and from this bill data generates bill summary information at a centrally located CF Station before transmitting the bill information to a customer at their payor station. The present invention does not require accumulating or compiling multiple bill communications at a customer's payor station to present summary bill information. Furthermore, the present invention allows a customer to review summary bill information from any payor station with connectivity to the CF Station.

Hogan, in either embodiment, fails to anticipate amended claims 34-53 in the present application. The present application is distinguishable over Hogan because Hogan fails to teach or suggest at least generating bill summary information "at a location remote from a customer ...." The first embodiment of Hogan in no way teaches displaying summary bill information and, thus, does not anticipate the present invention. In its second embodiment, Hogan's teaching is limited to compiling and displaying to a payor a list of unopened bills together with unpaid bills from multiple emails that are previously transmitted to the payor in the form of individual electronic bills. Furthermore, Hogan requires running an electronic bill presentment software program locally on a payor's computer to compile and display the list of unopened and unpaid bills. In marked contrast from the present invention, payors employing Hogan are severely limited to a personal computer running the electronic bill presentment software application to receive and parse electronic bill emails. Thus, even in the second embodiment, Hogan does not teach generating bill summary information "at a location remote from the customer."

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The Applicants have amended independent claim 44 in a manner similar to claim 34 and, therefore, respectfully submit that claim 44 is distinct over and not anticipated by Hogan for the same reasons as pertain to claim 34.

Accordingly, the Applicants respectfully assert that Hogan fails to teach every limitation of claims 34 and 44 and, therefore, claims 34 and 44 are not anticipated by Hogan under 35 U.S.C. § 102(a). Furthermore, dependent claims 35-39, 41, 43, 45-51, and 53 are allowable as a matter of law, as depending from an allowable claim, notwithstanding their independent recitation of patentable features. Finally, the Applicants have cancelled claims 40, 42, 52, 54-57, without prejudice or disclaimer, therefore rendering the Examiner's rejection under 35 U.S.C. § 102(a) moot.

Allowability of New Claims

The Applicants have added independent claim 70 that includes the limitation of "a means for processing bill data ... a means for storing the generated bill summary information ... and a means for transmitting th generated bill summary information ...." The Applicants respectfully submit that no new subject matter has been added and that claim 70 is allowable for the same reasons as stated above for independent claim 34, and therefore in condition for allowance.

Additionally, the Applicants have added dependent claims 58-69. The Applicants respectfully assert that new claims 58-69 are allowable as a matter of law, as depending from an allowable claim, notwithstanding its independent recitation of patentable features. Notwithstanding, the Applicants further describe dependent claim 58 as including the limitation of "displaying the generated bill summary information includes viewing a webpage over the Internet." The Applicants respectfully assert support for this amendment can be found in at least lines 20-22 on page 25 of the specification.

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